

THE JOINT EXAMINATION BOARD
PAPER P2 - PATENT AGENTS' PRACTICE

Monday 2nd November 2009

10.00 a.m. – 2.00 p.m.

*Please read the following instructions carefully. Time Allowed – **FOUR HOURS***

1. You should attempt **all of questions 1 to 6** in Part A and **two of questions 7 to 9** in Part B.
2. If more than two questions from Part B are answered, only questions 7 and 8 will be marked.
3. Please note the following:
 - a. start each question (but not necessarily each part of each question) on a fresh sheet of paper;
 - b. enter the Paper Number (P2), the question number and your Examination number in the appropriate boxes at the top of each sheet of paper;
 - c. the scripts are photocopied for marking purposes. Please write with a **dark inked pen** on one side of the paper only and within the printed margins, and do not use highlighters in your answer;
 - d. do not staple or join your answer pages together in any way;
 - e. do not state your name anywhere in the answers;
 - f. write clearly, as examiners cannot award marks to scripts that cannot be read;
 - g. reasoning should always be given where appropriate.
4. Under the Examination regulations **you may be disqualified from the examination and have other disciplinary measures taken against you if:**
 - a. you are found with unauthorised printed matter or other unauthorised material in the examination room;
 - b. your mobile phone is found to be switched on;
 - c. you copy the work of another candidate, use an electronic aid, or communicate with another candidate or with anyone outside the examination;
 - d. you continue to write after being told to stop writing by the invigilator(s). **NO WRITING OF ANY KIND IS PERMITTED AFTER THE TIME ALLOTTED TO THIS PAPER HAS EXPIRED.**
5. **At the end of the examination assemble your answer sheets in question number order and put them in the WHITE envelope provided.** Any answer script taken out of the examination room will not be marked.

PART A - ANSWER ALL QUESTIONS 1 to 6

1. On **6 November 2008** you filed a GB priority application for a client, John White, covering a product launched shortly after that date. When you call him it turns out that he wants to file a PCT application but won't have the finances to pay the official fees until early to mid-December.

He asks what are your recommendations and why?

7 Marks

2. Your client United Dough, a large European baker, has developed a new mixing head for its dough-mixing machine. They disclosed the head at two Bakers' Conventions. The earliest one, 6 months ago, was in the US and the later one was in Germany. Both these generated a lot of interest in the head. The head is visible when the ingredients are added and when the mixed dough is removed for subsequent processing but is not visible whilst the dough is being mixed. The angle of the blades on the new head has been changed which results in a head that is very distinctive in appearance but has no technical advantage. They have asked you what protection a registered design would provide and, if appropriate, the proposed timings for filing.

Prepare a memo for your discussion with them focusing only on registered designs.

10 Marks

3. Your client has a granted patent, filed **2 March 2005** and granted on **4 March 2008**, with a single claim to a watch battery comprising material **X**. This is the only possible use of **X**, which is a more cost effective alternative to previous materials. Your client wants to start an infringement action against three third parties - companies **A**, **B** and **C**. Companies **B** and **C** manufacture watch batteries using material **X**, which they purchase from company **A**. Company **A** supplies material **X** but does not manufacture batteries. All companies are UK based and manufacture and sell in the UK.

You investigate further and discover the following:

Company **A** has been advertising material **X** for sale since **July 2008**,

Company **B** began manufacturing and selling watch batteries made using **X** in **August** this year, and

Company **C** began manufacturing and selling watch batteries made using **X** two weeks ago.

You check the register and find the last renewal fee was not paid. Your client explains that due to some unfortunate and unforeseen family circumstances no action was taken on the case this year.

Advise your client what action can be taken and what rights can be enforced against A, B and C?

10 Marks

4. Your client has a patent granted in the UK directed to a process of making a new paint with previously unobtainable levels of shine and durability, for use on cars. He has no other rights in respect of the paint. The client comes to you today saying that he believes cars manufactured and finished in France with the special paint provided by a competitor based in France are being shipped into the UK by the car manufacturer. He wants to know if there is anything he can do to obtain compensation for the use of his invention.

Make notes for a discussion with the client in relation to the car manufacturer and competitor, including any further information you require from him.

8 Marks

5. At a meeting with your client, John Smith, he gives you details of a recently granted UK patent, No. 2999999, in the joint names of James Able and Joe Last, which relates to can-openers. Both James and Joe are also named as inventors on the patent. Your client provides you with:

an email from Joe Last admitting that he was not an inventor of the openers, and evidence that convinces you that your client and not Joe Last should be co-applicant and co-inventor with James Able.

Your client explains to you that he wishes the patent did not exist because he does not get on with James Able. Your client is intending to assemble can-openers in accordance with the patent and is concerned that James Able will take action against both his component suppliers and his customers.

What advice do you give to John Smith?

7 Marks

6. Your client, Engine Widgets Limited (EWL), is a manufacturer of engine components for worldwide distribution. They have a UK patent application, **GB2** filed **1 May 2009**, which claims priority from an identical earlier application, **GB1** filed on **1 May 2008**, which has now lapsed. You did not file any further priority claiming applications. **GB2** discloses a new type of fuel-injector with an unusual nozzle arrangement which gives equivalent performance to a conventional fuel-injector, although it can be manufactured substantially more cheaply.

During some development work, your client has discovered that the fuel-injectors of **GB2** are significantly improved by using a nozzle with a diameter in the range 0.1-0.15 mm (which was not disclosed in **GB2**) because it dramatically reduces fuel consumption. This improvement is likely to be a big commercial success. On investigation, you realise that **GB2** is to be published on **4 November 2009** and it is too late to avoid publication.

Explaining your reasoning, advise your client on a filing strategy that would give wide geographic protection to both their inventions, which maximises the patent term, to the fullest extent possible, and consider the prior art effect of GB1 and GB2 on your strategy.

8 Marks

PART B – ANSWER TWO OUT OF THREE QUESTIONS FROM QUESTIONS 7, 8 AND 9

7. Your client has recently launched a new product in the UK which is a child's inflatable spacehopper (bouncy toy) with extra bounce. The extra bounce is provided by using at least 10% of a commercially available material, polyex. However, use of over 25% polyex results in weakness in the spacehopper and the structure splitting prematurely. Polyex was known and used for many years as a flame-retardant. The client's marketing literature uses the slogan "contains polyex for extra bounce".

Your client has a recently filed, unpublished, patent application claiming the spacehoppers with extra bounce comprising polyex.

The client has called you today to discuss a letter received from FIXIT UK drawing attention to a granted European patent, **EP1**. The client has read the patent and says it relates to a solid ball with extra bounce and exemplifies solid balls comprising 50% polyex. He can't see what relevance it has to his activities. You look at the case and see that it contains two claims, Claim 1 of which is directed to:

A solid ball comprising at least 40% polyex.

Claim 2 relates to:

Use of polyex for increasing bounce.

The case was granted on **7 July 2009**.

The European case claims priority from a now lapsed GB application which discloses Claim 1 and exemplifies solid balls but makes no mention of any extra bounce provided by polyex. The basis for Claim 2 seems to have been first disclosed at the filing date but the claim itself was not added until just before grant. Your client thinks that FIXIT UK launched the solid balls after the priority date and before the filing date of **EP1**.

The client has asked you to call him to discuss the implications of the patent to sales of his product, his patent application and in particular if anything can be done to improve the situation. The spacehopper is the client's best selling product and he must be allowed to continue selling it.

25 Marks

8. You have been prosecuting a GB patent application for your client which broadly discloses a reinforced sock. The application was filed on **1 August 2005** without claiming priority. You expect that claims covering a product sold by the client, and limited to a sock reinforced at the toe and/or heel, will be allowed soon. Originally, the application as filed also contained specific claims to a sock comprising a reinforced ankle but these were found to lack unity with the toe and/or heel claims because the broad unifying claims in the application lacked novelty.

The client has come to you today saying that a large sock manufacturer has just launched a range of socks reinforced at the ankle, in the UK. The client has asked if the claims on file at present would cover this and, if not, if there is anything that could be done to cover a sock with ankle reinforcement or is it too late to get the competition off the market?

He also wants to know:

- what deadlines and associated fees need to be considered, and
- if he gets a claim covering the competitor, what can be done with it.

Make notes for your discussion with him making clear any actions you suggest.

25 Marks

9. A scientist employed by your client telephones you today in a panic because the new draft patent application you sent him, recently for review, was saved as a file on his laptop computer which was lost or stolen **yesterday**. The scientist works for a large defence company in the field of military technology. Generally, patent applications from this group are filed first in the UK and then subsequently all round the world, in particular Europe and US.

This is a fiercely competitive area of technology and he is worried that a competitor will get hold of the application and file on the invention, in particular, because the invention is a neat improvement to the competitor's technology that was contained in one of their recently published patent applications. The client started evaluating the technology, which ultimately they would like access to, when the improvement was identified.

Discuss, highlighting any recommendations:

- a) whether, and under what circumstances, there has been a disclosure, including any further information you require;**
- b) your proposed strategy and timings for protecting the improvement and any special considerations; and**
- c) what to do if the competitor files a patent application for the improvement.**